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REMARKS

Claims 1 to 32 were pending in the application at the time of final examination. Claims 1 to 32 remain rejected as anticipated.

Applicant respectfully requests reconsideration and withdrawal of the final rejection as premature. At this time, the record is incomplete and so the issues are not clearly defined for appeal.

First, the rationale for continuing the rejection relies upon a definition from a dictionary that was only cited in a footnote as "Microsoft Computer Dictionary, Fifth Edition." The reference was not cited on a PTO Form PTO-892, and a date of publication was not provided. Also, since the reference is a non-patent reference, a copy should have been included with the action. Accordingly, the record is incomplete, because a reference was relied upon which was not properly documented in the rejection.

Second, the final rejection stated:

> Examiner was unable to find above definition in paragraph 21 of the specification.

Applicant cannot understand the basis for this comment. Applicant's attorney accessed the specification on Public Pair. In Paragraph 21, at Page 10 in lines 5 to 3 from the bottom, of the Public Pair specification were exactly the words quoted as the definition in the prior response with the exception that the typographic error was not corrected in the specification on Public Pair. Thus, the definition was available to the Examiner as quoted and should have been considered. Since the record shows that Applicant's remarks in the prior response were not fully considered, the final rejection is incomplete because the explicit definition should have been considered.

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Accordingly, the record has not been fully developed for multiple reasons.

It is clear that in view of the incompleteness of the record, the Appeals Board would simply return the appeal to have the record completed. Accordingly, Applicant respectfully requests withdrawal of the final designation of the instant action.

Claims 1 to 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0116702, hereinafter referred to as Aptus.

Applicant respectfully traverses the anticipation rejection of Claim 1. Applicant notes that for an anticipation rejection, the MPEP requires:

> **TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**
>
> .... < "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, 8th Ed., Rev. 3, p. 2100-76 (August 2005).

Applicant further notes that an improper claim interpretation has been used and the explicit requirements of the MPEP have not been followed. Claim 1 recites in part "main interfaces defining versioning functionality. . . " The second element is a functional implementation of the main interfaces.

To determine whether Aptus teaches the elements as required by Claim 1, it is necessary to interpret the claim limitations. The rejection argues since the claims are interpreted broadly, explicit claim limitations and definitions from the specification can be ignored, and that a dictionary definition that considers neither the claim limitations nor the environment of the invention as described in the specification can be used to interpret the claim limitation.

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The MPEP provides a specific sequence of steps that are to be followed in such a claim interpretation and these steps clearly were not followed in the final rejection.

The MPEP requires:

> Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 3, p 2100-7,8 (August 2005).

The MPEP further requires:

> Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.
>
> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. (Emphasis added.)

MPEP § 2106 C., 8th Ed., Rev. 3, p 2100-8, (August 2005). The above discussion of the rejection demonstrates that these requirements of the MPEP have not been followed with respect to claim interpretation. If the requirements had been followed, it should have been unnecessary for Applicant to cite to the definition. Even after the definition was cited, a dictionary definition was used as justification for interpreting Aptus to read on Claim 1. This is clear error and is further evidence that the above criteria were not followed.

While the Examiner is permitted to interpret the claims broadly, the MPEP and the courts put specific limitations on such an interpretation. In particular, limitations are placed on when a dictionary definition can be used, and in the instant application, such use is inappropriate. Specifically,

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CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

> During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." (Emphasis Added.)

MPEP § 2111 8th Ed. Rev. 3, p 2100-46 (August 2005).

> The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.

MPEP § 2111 8th Ed. Rev. 3, p 2100-47 (August 2005).

> **>Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

MPEP § 2106 C., 8th Ed. Rev. 3, p 2100-8 (August 2005).

Thus, Applicant respectfully submits, in view of these requirements, the interpretation used in the rejection of Claim 1 is neither related to Applicant's claim language nor related to the interpretation that would be used by those of ordinary skill in the art. Further, the MPEP directs "Office personal must rely on the applicant's disclosure to properly determine the meaning of the claim." (Emphasis added.) Id. This statement alone is sufficient to demonstrate the claim interpretation used in the final rejection is inappropriate.

Determining the plain meaning of claim limitations is not reading limitations into the claims as alleged in the final rejection, but rather is complying with the statutory requirements as interpreted by the courts and the PTO. In particular, the MPEP elaborates on the criteria for determining the plain meaning of claim limitations.

2111.01 Plain Meaning [R-3]

I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION

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> ... During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, **>367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). . . . This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. . . . . It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. (Emphasis Added.)

MPEP § 2111.01, 8th Ed. Rev. 3, p. 2100-47, 48 (August 2005).

Thus, the MPEP unequivocally describes the limits on using the plain meaning. Applicant has provided a clear definition of "interface" in the specification. The above quotes from the MPEP demonstrate that the analysis in the final rejection based on a contrary dictionary definition is not well founded.

The MPEP further unequivocally stated the specification can be used to interpret claim language when a definition is provided as in the instant application. Thus, the MPEP makes clear that such an interpretation is not reading limitations into the claims as stated in the final rejection.

The MPEP further directs:

> ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.")

MPEP § 2111.01 II., 8th Ed. Rev. 3, p. 2100-49, 48 (August 2005).

Thus, the MPEP directs that when there are several possible meanings, i.e., the one used in the dictionary and the one given in the specification, the disclosure serves to point away from the improper meaning, which in this case in the dictionary definition used to justify maintaining the anticipation rejection.

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A recent CAFC ruling, Philips v AWH Corp, 75 U.S.P.Q.2d 1321, 1334 (CAFC July 2005) reconfirms this point:

> at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent document. (Emphasis Added).

The dictionary definition of "interface" used in the final rejection contradicts the explicit definition given in the specification and so fails to comply with the holding in the case.

Applicant has cited numerous different rulings and they are all consistent on how claim limitations are to be interpreted when an explicit definition is given in the description. The final rejection clearly did not follow these requirements and presented a rationale that directly contradicts the explicit requirements. If there is still any doubt as to how the claim interpretation is to be done when a definition is provided in the specification, the MPEP gives a concise statement:

> Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2106 C., 8th Ed. Rev. 3, p 2100-8 (August 2005).

Applicant incorporates herein by reference the remarks from the prior response and respectfully submits that when a proper interpretation of the claim limitations is used in compliance with the above requirements that the remarks are persuasive. Accordingly, the anticipation rejection of Claim 1 is not well founded on multiple grounds. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

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Claims 2 to 14 depend from Claim 1 and so distinguish over the Aptus for at least the same reasons as given above for Claim 1, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 14.

Claim 18 stands rejected based on the rationale quoted above for Claim 1 with respect to paragraphs [0089] and [0093] of Aptus. Accordingly, the above comments with respect to Claim 1 are applicable to Claim 18 and are incorporated herein by reference. In addition, Applicant respectfully notes that the interpretation of the first and second libraries depends on the Claim being rejected--Compare the rejection of Claim 6 with the rejection of Claim 18. The rejection itself demonstrates an inconsistency in the interpretation of Aptus and so is further evidence that Aptus fails to satisfy the requirements of the MPEP as quoted above. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 18.

Claims 19 to 32 depend from Claim 18 and so distinguish over the Aptus for at least the same reasons as given above for Claim 18, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 19 to 32.

Claims 1 to 32 remain in the application. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. 571-273-8300, on March 3, 2006.

Rivkah Young
Rivkah Young March 3, 2006
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Respectfully submitted,

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